

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of	:	Jorg Peetz, et al.
Serial No.	:	10/552,228
Filed	:	October 6, 2005
Art Unit	:	2464
Examiner	:	Ben H. Liu
Att. Docket	:	DE 030108
Confirmation No.	:	6701

REPLY BRIEF
On Appeal from Group Art Unit 2464

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Sir:

In addition to the arguments presented in the Appeal Brief filed on October 29, 2010, and in response to the Examiner's Answer dated January 18, 2011, Appellant submits the following reply.

REMARKS

This Reply Brief is in response to the Examiner's Answer dated January 18, 2010. Reconsideration of this application is respectfully requested in view of the following remarks and all of the arguments in the Appeal Brief of October 29, 2010 and prior responses.

STATUS OF CLAIMS

- a) Claims 1-15 are pending at the time of filing this Appeal Brief, stand rejected in a final Office Action dated June 07, 2010, and are the subject of this appeal.
- b) Claims 1, 5, 9, and 11 are independent.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

- A. Whether claims 1-2, 5-6, 9-15 are properly rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 6,816,502 to Ekl, et al. (hereinafter Ekl) in view of U.S. Patent 6,259,898 to Lewis (hereinafter Lewis) and U.S. Patent 6,665,520 to Romans (hereinafter Romans).
- B. Whether claims 3 and 7 are properly rejected under 35 U.S.C. §103(a) as being unpatentable over Ekl in view of Lewis and Romans, and further in view of U.S. Patent 6,018,642 to Adachi (hereinafter Adachi).
- C. Whether claims 4 and 8 are properly rejected under 35 U.S.C. §103(a) as being unpatentable over Ekl in view of Lewis and Romans, and further in view of alleged admitted prior art (hereinafter APA).
- D. Whether Claims 1-15 are properly rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claim 1 of U.S.

Patent No. 6,556,576 to Du, et al. (hereinafter Du I) in view of Lewis and Romans.

E. Whether Claims 1-15 are properly rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No. 7,457,298 to Du et al. (hereinafter Du II) in view of Lewis and Romans.

ARGUMENT IN RESPONSE TO THE EXAMINER'S ANSWER

Appellant respectfully traverses the rejections in accordance with the detailed arguments set forth below. The Examiner responds to Appellant's remarks starting on page 23 of the Examiner's Answer. Appellant respectfully disagrees with the Examiner's comments for at least the following reasons.

Claim 1:

Independent claim 1 requires:

Independent claim 1 requires:

"signaling the switching operation and the unavailability of the bridge terminal by means of a power saving signal of the communication network." [Emphasis added].

In response to Appellant's argument that Lewis does not signal the switching operation between subnets and further does not signal the unavailability for the first subnet when operating in the second subnet, the Examiner asserts that:

"one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See In re

Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); In re Merck & Co., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986)."

However, the Examiner asserts that the feature of signaling the switching operation and the unavailability of the bridge terminal, is not shown by Ekl, but rather by Lewis. The Examiner does not point to any other reference as allegedly teaching this feature. If this specific feature is disclosed by a combination of reference, the Examiner has not shown that in the final Office Action. For example, on page 11 of the Answer, it is asserted that:

*"Ekl et al. disclose all the subject matter of the claimed invention with the exception of signaling the switching operation. However, Lewis from the same or similar fields of endeavor discloses a wireless access point (see figure 2, access point 19) that communicates with different subsets of mobile stations (see figure 1, MT 21). The access point 19 broadcasts a beacon that indicates the **availability** of the access point (see column 6 lines 48-59). Thus, it would have been obvious to the person of ordinary skill in the art at the time of the invention to **use the beacon that indicates the availability** of the access point as taught by Lewis with the system that communicates with two sets mobile terminals at different periods as taught by Ekl et al. [emphasis added]*

Further, on page 24 of the Answer, the Examiner states that the secondary reference, Lewis, is combined with the primary reference, Ekl, to disclose the signaling of the actual switching operation using a beacon signal. Thus, only Lewis was cited against this feature, therefore it is unclear to the Appellant how one can address this rejection by attacking references that were not cited against the limitation, and in fact where the reference was admitted to as not showing the limitation.

In addition, Appellant stated that Lewis fails to show the feature of "signaling of...", as Lewis teaches that the mobile terminals can communicate on both channels. Thus, a mobile station can always register with the access point (either in the first or

second transceiver), and the access point is always available for the mobile devices. Thus, the beacon, as disclosed by Lewis, does not signal the switching operation between subnets and further does not signal the unavailability for the first subnet when operating in the second subnet.

The Examiner attempts to clarify the rejection on page 25 of the Answer, where it is stated that:

“the secondary reference of Lewis discloses a beacon from a base station that indicates the availability of a first transceiver using a first communication channel for registering mobile stations. When the first transceiver becomes unavailable, then the beacon is modified to indicate a switch to a second transceiver using a second communication channel for registering additional mobile stations.”

It is submitted that the Examiner misunderstood the teaching of Lewis. For example, at column 6, lines 48-58 Lewis teaches:

“[i]n a passive type registration system, the processor 30 may cause the primary transceiver 36a to broadcast a beacon periodically, the beacon indicating whether registration is possible. A mobile terminal 21 desiring to register will receive such beacon and respond in a conventional manner. Upon such time that the primary transceiver 36a reaches the predefined limit, the processor 30 instructs the transceiver 36a to modify the beacon such that registrations are not possible. In its place, the processor 30 causes the transceiver 36b periodic beacon to indicate registration availability in order that mobile terminals may register via the secondary transceiver 36b.”

As understood from the above citation, the beacons operable in Lewis' access point merely indicate whether a mobile terminal can register to the first transceiver or second transceiver. That is, whether a mobile terminal can communicate with the access point over the first or second channel. Further, Lewis teaches that mobile terminals can communicate on both channels. Thus, a mobile station can always register with the access point (either in the first or second transceiver), and the access point is always available for the mobile devices. Thus, the beacon, as disclosed by

Lewis, does not signal the actual switching operation, in contrast to the Examiner's assertion.

The Examiner further asserts that the primary reference of Ekl is cited to teach the actual switching operation of the bridge terminal between a first subnet and a second subnet. Further, on page 26 of the Answer, the Examiner states that according to the bridge terminal disclosed by Ekl, once the mobile station registers with a subnet, then that mobile terminal can only communicate with that particular subnet when it is available. Applicants respectfully disagree. According to Ekl and the Examiner, any association between devices in the subsets is performed prior to the switching between subnets.

Lewis teaches beacons that indicate whether a mobile terminal can register to the first transceiver or second transceiver. Lewis' beacons can be utilized in the context of Ekl's disclosure merely to determine which mobile stations belong to the first or second subnet. Therefore, it is improper to assume that the actual switching of Ekl's access point can be signaled by the beacons of Lewis, as during the normal operation of the access point (i.e., the switched) all mobile stations should be registered with the access point. Therefore, the beacons disclosed by Lewis cannot be utilized for signaling the switching of Ekl's access point.

On page 26 of the Answer, the Examiner simply asserts that Appellant's arguments against the Romans was not considered as, one cannot show non-obviousness by attacking references individually. The Examiner attempts to clarify the rejection by pointing out that Romans is additionally cited to modify the beacon signal to include a wakeup flag. In addition, the Examiner asserts that when the bridge terminal becomes unavailable for one subnet during a time period, as disclosed by Ekl and Lewis, then the wakeup flag as disclosed by Romans can be used to command a mobile station to enter sleep mode. Appellant has shown why the teachings of Romans cannot be modified as suggested by the Examiner and specifically the modification of beacons does not result in the claimed invention.

Romans teaches if the wake-up flag for a mobile station is set in the CP Beacon, the station remains awake and broadcasts a Power Management Status message. This message notifies any station that wishes to communicate with the mobile station that

the station is awake and able to receive messages. If the CP Beacon does not include a wake-up flag for this station, then the station may immediately go back to a low power mode. The wake-up flag in the CP Beacon is cleared when the CP receives a Power Management Status message from the mobile station.

Therefore, according to the teachings of Romans the status of the wake-up flag is set by the mobile system. However, in order to signal the availability of the bridge terminal, the status of the wake-up flag should be controlled by the bridge terminal. Thus, the wake-up flag disclosed in Romans cannot be viewed as the claimed “power saving signal.” Further, as stated by the Examiner and as clearly can be understood from the teachings of Romans, the wake-up flag and the CP beacon command a mobile station to enter sleep mode. However, in direct contrast, the power saving signal is used to signal the unavailability of the bridge terminal, and not the unavailability of mobile stations that bridge terminal communicates with. Therefore, modifying the beacon signal to include a wake-up flag disclosed by Romans will not result in the claimed invention.

Appellant respectfully submits that in order render claim 1 unpatentable, the Examiner must do more than merely “consider” each and every feature for this claim. Instead, the asserted combination of the patents to Ekl, Lewis, and Romans must also teach or suggest *each and every claim feature*. See *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974) (emphasis added). Indeed, as the Board of Patent Appeal and Interferences has recently confirmed, a proper obviousness determination requires that an Examiner make “a searching comparison of the claimed invention – *including all its limitations* – with the teaching of the prior art.” See *In re Wada and Murphy*, Appeal 2007-3733, *citing In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis in original).

Further, the necessary presence of all claim features is axiomatic, since the Supreme Court has long held that obviousness is a question of law based on underlying factual inquiries, including ... ascertaining the differences between *the claimed invention* and the prior art. *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966) (emphasis added). In fact, Appellant submits that this is why the MPEP §904 instructs Examiners to conduct an art search that covers “***the invention as described and claimed.***” (emphasis added).

Lastly, Applicant respectfully directs attention to MPEP § 2143, the instructions of which buttress the conclusion that obviousness requires at least a suggestion of all of the features of a claim, since the Supreme Court in *KSR Int'l v. Teleflex Inc.* stated that “there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR Int'l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

In summary, it remains well-settled law that obviousness requires at least a suggestion of all of the features in a claim. See *In re Wada and Murphy, citing CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) and *In re Royka*, 490 F.2d 981, 985 (CCPA 1974)).

Contrary to above provisions, on page 28 of the Answer, it is asserted that:

“it is noted that the term “terminal” is used to refer to the mobile stations of the network disclosed by Ekl et al. By allowing the mobile station to enter a sleep mode when the bridge terminal is unavailable, the power used by the mobile terminals is conserved. Since the beacon signal allows mobile stations to conserve power, such a beacon is interpreted as a “power saving signal of the communication network” as disclosed by the claim.”

It is respectfully submitted that the Examiner misinterpreted the claimed invention and the above reasoning for combining the references cannot be applied against the claimed invention. Specifically, nothing in the claimed invention requires the mobile station to enter a sleep mode. The fact that the beacon allows the mobile stations to conserve power cannot be interpreted as a “power saving signal of the communication network” as such signal is not defined in the related art. The purpose of the signal is to indicate the **unavailability of the bridge terminal**. The bridge terminal is the access point in Ekl’s disclosure, not the mobile stations. Thus, the mobile station may be in a sleep mode, but still the access point can be available for communication.

Therefore, the Examiner fails to show that the combination of Ekl, Lewis, and Romans supports a *prima facie* case of obviousness at least as required by the provisions set-forth above.

Regarding the remaining claims, in view of the above, and arguments presented in pervious responses and in the Appellant's Appeal Brief, it is clear that the cited references do not disclose the claimed invention. Therefore, it is respectfully submitted that the Examiner failed to show the combination of Ekl, Lewis, and Romans supports a prima facie case for obviousness.

CONCLUSION

In light of the above, Appellants respectfully submit that the rejection of claims 1-15 are in error, legally and factually, and must be reversed.

Respectfully submitted,

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